

Docket No. Docket CT-DST-1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of SCOUTEN et al)
Serial No. 10/036,231) Examiner: S.K. Webb
Filed December 24, 2001) Art Unit: 3731

Title: STEREOTAXIC MANIPULATOR WITH RETROFITTED LINEAR SCALES
AND DIGITAL DISPLAY DEVICE

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the
United States Postal Service as first class mail in an envelope
addressed to: MS NON-FEE AMENDMENTS, Asst. Commr. for Patents, P.O. Box
1450, Alexandria, VA 22313-1450, on August 23, 2004.

Name of Registered Representative: Patrick D. Kelly

Signature: Patrick D. Kelly

Date: 23 Aug. 2004

INFORMATION DISCLOSURE STATEMENT

Asst. Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Applicant hereby submits the enclosed cited art, along with
PTO Form SB-08. These items are being submitted before any
substantive examination; therefore, no fee is due.

All three submitted items apparently were created by Joseph
Saracione. The Examiner is requested to note that in the 2000
advertisement, the picture clearly shows a stand-alone display
device, with all three digital readouts.

However, in the 6,258,103 patent (filed in 2000), no such
display device is illustrated; and, to the best of the
undersigned attorney's knowledge after a careful review of the
text, no such stand-alone display device is mentioned or

discussed, anywhere in the specification or claims. Instead, the stand-alone display is replaced entirely by the three small single-axis digital readouts, mounted directly on the three orthogonal arms of the manipulator itself. These are shown in FIGS. 3 and 4 by callout numbers 220, 222, and 224, and they are described at column 11, lines 33-46, and column 21, lines 45-51.

That arrangement, shown and described in Saracione's '103 patent, is important, because anyone who uses this type of equipment, in a procedure on a lab animal, absolutely must be able to read the digital values on all three scales, at any given moment during a procedure on an animal. That functional and operational requirement is absolutely crucial and essential, to proper use of the device.

In view of that factor, the "best mode requirement" moves into the forefront, and demands attention. If Mr. Saracione knew or even contemplated, on the day his application was filed, that having all three digital values displayed *on a stand-alone digital readout device* (rather than having three different displays mounted directly on the three arms of the manipulator) was indeed the "best mode" of carrying out that essential aspect of the invention, then Mr. Saracione was subject to an absolute, binding, mandatory obligation to disclose that best mode, in his application.

However, he did not take that approach, at all. Instead, the "best mode" he disclosed used three different single-axis readouts, mounted in three different locations, on the arms of his manipulator.

That was fine, for Mr. Saracione's purposes. However, in this current pending application, the Applicants herein went in a different direction. As it turned out, by going in a direction different from the teachings of Saracione's '103 patent, the Applicants herein did two things. First, they created an important commercial success, which led to the widespread adoption and use of their instruments as a new standard throughout the neurology research community, rather than being limited to just a small number of research labs. Second, they

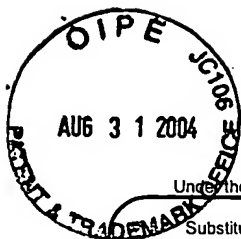
created a foundation that subsequently led to an even better and more important invention, involving manipulator arms that can be rotated and tilted in controlled and accurately measured ways; by creating and developing their dedicated display device with additional embedded software that can provide calculated adjusted orthogonal values despite the angular displacements, they enabled and created a highly important advance in the art, which could not be accomplished by the system taught by Saracione's '103 patent. This factor should be regarded as an important "secondary consideration" by the Examiner.

Finally, with regard to the two cited advertisements, it should be noted that (to the best of the Applicants' knowledge and belief) the two companies listed in those ads (Saracione-Hill Instruments, and its successor, Cartesian Research, Inc.) are no longer in business.

Respectfully submitted,

A handwritten signature in cursive script, reading "Patrick D. Kelly". The signature is written in dark ink and is positioned above the typed name and address.

Patrick D. Kelly
Attorney for Applicants
Reg. No. 30,650
11939 Manchester #403
St. Louis, MO 63131



PTO/SB/08A (08-03)

Approved for use through 07/31/2006. OMB 0651-0031

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Substitute for form 1449/PTO		Complete if Known	
		Application Number	10/036,231
INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Use as many sheets as necessary)		Filing Date	24 DEC. 2004
		First Named Inventor	SCOUTEN
		Art Unit	3731
		Examiner Name	S. K. WEBB
		Attorney Docket Number	CT-DST-1
Sheet	1	of	2

U. S. PATENT DOCUMENTS					
Examiner Initials*	Cite No. ¹	Document Number	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
		Number-Kind Code ² (if known)			
		US- 6,258,103	07-10-2001	Saracione	FIG. 4, 220-224,
		US-			col. 11, lines 33-46
		US-			col. 21, lines 45-51
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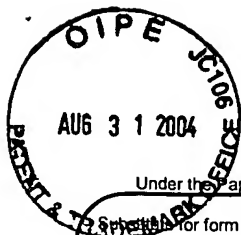
FOREIGN PATENT DOCUMENTS						
Examiner Initials*	Cite No. ¹	Foreign Patent Document	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages Or Relevant Figures Appear	T ⁶
		Country Code ³ -Number ⁴ -Kind Code ⁵ (if known)				

Examiner Signature	Date Considered
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*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. ¹ Applicant's unique citation designation number (optional). ² See Kinds Codes of USPTO Patent Documents at www.uspto.gov or MPEP 901.04. ³ Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). ⁴ For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. ⁵ Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. ⁶ Applicant is to place a check mark here if English language Translation is attached.

This collection of information is required by 37 CFR 1.97 and 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PTO/SB/08B (08-03)

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9 Spent for form 1449/PTO

**INFORMATION DISCLOSURE
STATEMENT BY APPLICANT**

(Use as many sheets as necessary)

Complete if Known

Application Number	10/036,231
Filing Date	24 DEC. 2001
First Named Inventor	SCOUTEN
Art Unit	3731
Examiner Name	S. K. WEBB
Attorney Docket Number	CT-DST-1

Sheet	2	of	2
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NON PATENT LITERATURE DOCUMENTS

Examiner Initials*	Cite No. ¹	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T ²
		Society for Neuroscience, 24th Annual Meeting, 1994, Exhibit Guide, advertisement by Saracine-Hill Instruments	
		Society for Neuroscience, 30th Annual Meeting, 2000, Exhibit Guide, advertisement by Cartesian Research Inc.	

Examiner Signature		Date Considered	
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1 Applicant's unique citation designation number (optional). 2 Applicant is to place a check mark here if English language Translation is attached.

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